

## REMARKS

In the Office Action, the Examiner rejects Claims 1-16. Claims 1-2, 5-10, 13-16 are rejected under 35 U.S.C § 103(a) as being unpatentable over Kadowaki et al. (U.S. Pat. 5,414,457) (hereinafter "Kadowaki") in view of Matsubara et al. (U.S. Pat. 5,345,258) (hereinafter "Matsubara").

The Examiner contends that Kadowaki discloses a telephone unit having a telephone directory with picture data comprising video images, an interface for receiving compressed image data, a decoding means, a correlating means for correlating the image signal with a telephone number and a registering means.

The Examiner does acknowledge that Kadowaki fails to specifically teach receiving compressed moving picture data from the distance party so that the first decode means decodes the compressed moving picture data into compressed still picture data in order to register the data. However, the Examiner asserts that Matsubara teaches this limitation.

Therefore, the Examiner contends that it would be obvious to one of ordinary skill in the art to modify Kadowaki such that the system is capable of receiving compressed moving pictures wherein the telephone unit includes a first decode means for decoding the compressed moving data and a encoding means for encoding one or more frames of the moving picture into compressed still picture data to register.

Kadowaki appears to disclose a communication apparatus with an image encode/decode unit 20 to encode an image signal to be transmitted to a given party and a receiving means. Images and telephone numbers can be registered using a touch sensor 41 (registration means). See Col 3, lines 57-64. This reference also discloses a

correlation means, the RAM 50, which functions as a memory for storing a selection signal for the telephone number of the calling party in correspondence with a received image.

Further, if the CPU determined that the registration start sensor is depressed, a received image signal and a selection signal for a calling party are registered in the RAM in correspondence with each other. See Col 4, lines 46-68. However, the disclosed correlation means appears to be *a uni-directional correlation* having a selection signal for a telephone number corresponding to the image.

In contrast, the Claim 1 recites, inter alia, a telephone unit having a telephone directory comprising a correlation means for correlating compressed still picture data with a telephone number. The claimed correlation means is a bi-directional correlation.

Kadowaka does not teach a bi-directional correlation means, whereby both the image and the telephone number are correlated such that if the user views the telephone number an image automatically appears and vice versa. In other words, Kadowaka does not disclose a selection signal for an image corresponding to a telephone number as well as a selection signal for a telephone number corresponding to the image.

Furthermore, Claim 1 recites, inter alia, an encoding means for encoding one or more frames of the decoded moving picture data into a compressed still picture data.

Matsubara discloses a videophone with a decoding circuit which decodes digital video images. The coding circuit encodes the decoded images inputted from the

decoding circuit frame by frame and stores the frames within the storage circuit. See Matsubara Col 4, lines 17-34.

According to Matsubara, the moving picture, which is encoded by the coding circuit 22B and stored in the storage circuit 19B is decoded by the decoding circuit 18B in playback mode afterwards. The decoding circuit 18D is used to decode the encoded moving picture transmitter. Accordingly, the picture encoded by the coding circuit is at least compatible with a moving picture. Furthermore, this is evident from the explanation that the first frame is encoded into intra-frame code and the following frames are encoded into a DPCM code. See, Col 8, lines 36-42. In Matsubara, it is necessary to store frames which begin with the frame at the detection of a storage start signal and to playback the frame afterwards. Therefore, the frame at the detection of the storage start signal must be encoded in the intra-frame code which does not require a previous decoding frame. Thus, the frame encoded by the coding circuit 22B is a part of a moving picture.

In stark contrast, the present invention as claimed, has the specific limitation of an encoding means for encoding one or more frames into a compressed still picture data and then correlating the still picture data with the phone number. Matsubara teaches away from this limitation, as the frames are intra-frame coded, and therefore Matsubara does not use a previous decoding frame. Furthermore, converting or encoding a compressed still picture data from one or more moving picture frames, as claimed, would require the use of one or more decoded picture frames.

Moreover, neither prior art reference cited by the Examiner teaches or discloses, both converting one or more frames of a moving picture into compressed still

picture data and then correlating the still picture data with a number in a telephone directory.

Accordingly, applicant respectfully submits that Claims 1-2, 5-10, 13-16 are patentably distinguished from the combination of Kadowaki and Matsubara.

In the Official Action, the Examiner also rejects Claims 3-4 and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Kadowaki in view of Matsubara and in further view of Kimura et al. (U.S. Pat. 5,778,054) (hereinafter "Kimura"). The Examiner asserts that Kimura teaches a storage device storing access information where the information is registered in JPEG format so that it recognizes the access information being recorded in a comment segment of the JPEG file. The Examiner states that it would have been obvious to one of ordinary skill in the art to modify the Kadowaki-Matsubara combination to store the telephone numbers in JPEG format with access information being recorded in the comment segment of the JPEG file.

We respectfully disagree with the Examiner's rejection and traverse with at least the following additional reasons. According to Matsubara, the frame code generated by the coding circuit 22B is in conformity with a moving picture format. On the other hand, Claims 3-4 and 11-12 recite that the information is registered in JPEG format so that it recognizes the access information being recorded in a comment segment of the JPEG file, a still picture format. The still picture data generated by the encoding means of the present invention is not compatible with a moving picture format such as H.263 and MPEG 4, which the moving picture of Matsubara is in conformity. One would not be motivated to combine Matsubara, Kadowaki and Kimura since the moving

picture encoding of Matsubara and Kadowaki would not be compatible with the still picture or JPEG encoding of Kimura.

Accordingly, Applicant respectfully submits the Claims 3-4 and 11-12 are patentably distinct from the reference cited as the combined references, either taken alone or in combination thereof, do not teach encoding one or more frames of a decoded moving picture data into compressed still picture data and storing telephone numbers in JPEG format where the numbers are recorded in the comment segment of the JPEG file.

Lastly, Applicant submits new Claims 17-18 for examination herewith. Claims 17 and 18 are dependent on Claims 1 and 9, respectively. Claim 17 recites, inter alia, a telephone unit having a telephone directory with picture data wherein the still picture data generated by said encoding means is in conformity with a format different from a format with which the moving picture data is in conformity. As stated above, Matsubara and Kadowaki disclose moving picture encoding and data which is in the format in conformity with moving picture data. While Kimura discloses using a JPEG format, which is a format different from a format with which the moving picture data is in conformity, one would not make such a combination of Kimura with either reference as they are not compatible. Even if one would combine the references, such a combination is not suggested by the prior art. Furthermore, such a combination would not function properly, as one would not be able to playback frames of a moving picture, in order to view them, frames stored in JPEG format (still picture data) without an additional conversion circuit or an additional step. Such a playback function appears to be a goal of Matsubara, and therefore one would not substitute still picture data for the

moving picture data of Matsubara. Further, neither the additional conversion circuit nor the additional step is taught or disclosed by the cited prior art references.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Seth Weinfeld", written over a horizontal line.

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